

REMARKS

In response to the Office Action dated August 24, 2006, Applicant respectfully requests reconsideration and withdrawal of the rejections of the claims.

Claims 1, 5, 6, 10, 11, 13 and 20 were rejected under 35 U.S.C. §103, on the basis of the previously-cited Grealish patent in view of the newly cited Barney et al patent (U.S. 6,556,992). The remaining claims were rejected on the basis of these two patents, in further view of the Unger patent. It is respectfully submitted that these references do not suggest the claimed subject matter to a person of ordinary skill in the art, whether they are considered individually or in combination.

First, it is to be noted that the rejection is directed to an older version of the claims, rather than the amended version that was presented on May 31, 2006. For instance, the paragraph bridging pages 2-3 of the Office Action quotes claim 13 as it existed prior to the May 31, 2006 Amendment. As such, it is not apparent from the Office Action how the references are being applied to the amended claims that were pending at the time of the rejection.

Second, it is respectfully submitted that the Office Action does not establish that the Barney patent qualifies as prior art against the claims of the present application. The Barney patent has a U.S. filing date of September 14, 2000. The present application claims the benefit of provisional Application No. 60/197,778, which was filed April 14, 2000.

It is noted that the Barney patent refers to an earlier provisional application filed on September 14, 1999. However, the disclosure of that provisional application is not commensurate with the specification of the issued Barney patent. In particular, passages that are cited in the rejection of the claims do not appear in the earlier

provisional application of September 14, 1999. For instance, there is a substantial amount of new text in the passage at column 4, line 14 to column 13, line 8, cited in the Office Action. Similarly, text in column 28, line 5 to column 30, line 43, is not present in the provisional application. Consequently, the subject matter of the Barney patent that is relied upon in the rejection is only entitled to an effective date of September 14, 2000, which is subsequent to the priority date of the present application.

Accordingly, it is respectfully submitted that the Office Action does not establish a proper basis for rejecting the claims over the Barney patent. If the rejection is not withdrawn, the Examiner is respectfully requested to identify support for the rejection within the disclosure of the provisional application that was filed September 14, 1999. In the absence of such a showing, it is respectfully submitted that the rejection is not supportable.

Page 3 of the Office Action describes certain aspects of the Grealish patent. However, it is not apparent from this description how the Grealish patent is being interpreted to suggest the subject matter of the claims. Specifically, the rejection does not link the disclosure of the Grealish patent to the language of the claims. For example, claim 1 recites a method which includes, among other steps, importing data from fields in a database, storing the imported data as records in at least one internal database, and "linking the imported data to corresponding earlier stored records and/or groupings." The Office Action does not address this claimed feature, nor is it apparent how the Grealish patent is being interpreted to suggest this subject matter. For instance, what is considered to be the earlier stored records in the

Grealish patent, and where does the patent disclose that "imported" data is linked to such earlier stored records?

Another sequence of steps recited in claim 1 comprises grouping the imported data into at least one category, selecting at least one category for viewing, and retrieving the records from the selected categories. Again, the Office Action does not address these claimed features, nor identify where the Grealish patent discloses corresponding subject matter.

As set forth in MPEP § 2143.03, one of the requirements for a rejection under 35 U.S.C. § 103 is that "all the claim limitations must be taught or suggested by the prior art." The general discussion of the Grealish patent on page 3 of the Office Action does not meet this requirement. If the rejection is not withdrawn, it is respectfully requested that the Examiner identify where the reference discloses each element or step of the claim that it is being relied upon to suggest. In the absence of such a showing, it is respectfully submitted that a proper basis for the rejection has not been established in the record.

The Office Action acknowledges that the Grealish patent does not disclose the presentation of statistical information about selected data in a spreadsheet user interface by designated category. To this end, therefore, reliance is made upon the Barney patent. While the Barney patent generally discloses a statistical patent rating system, it does not disclose, nor otherwise suggest, the specific subject matter recited in the claims.

For instance, each of claims 1, 13 and 20 recites that the statistical information is displayed "in a spreadsheet user interface." Neither the Grealish

patent nor the Barney patent discloses a spreadsheet user interface for displaying statistical information. The Office Action refers to Figures 2a-2e of the Grealish patent. As disclosed at column 7, lines 25-26, these figures illustrate "various views of an exemplary database application program's display". In other words, the grids in these figures display database records. There is no disclosure that these figures constitute a spreadsheet user interface.

Likewise, the Barney patent does not disclose a spreadsheet user interface for the display of statistical information. Rather, Figures 4-10 comprise bar charts, Figure 11 is a textual report, and Figure 12 is a line graph. None of these figures suggests the user of the spreadsheet user interface to present statistical information.

Since neither of the Grealish nor Barney patents discloses the use of a spreadsheet user interface to present statistical information, any possible combination of their teachings would not produce such a result. For this additional reason, therefore, the references do not support the rejection.

Further distinguishing features are set forth in the dependent claims. In view of the foregoing arguments, it is believed that a detailed discussion of these additional distinctions is unnecessary at this time.

In summary, the claimed subject matter presents a methodology and system for importing data from any bibliographic database and, based upon the user's choice of categories, store and statistically group the data to construct a spreadsheet user interface. As disclosed in the application, this functionality enables the user to evaluate the validity or strength of patents, groups of patents, or patent portfolios. The cited references, whether considered individually or in combination, do not

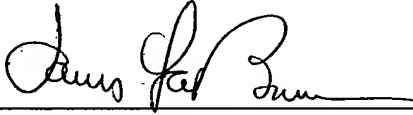
suggest a mechanism to automatically import, store, group and link bibliographic data with the flexibility to define categories as desired.

For at least the foregoing reasons, therefore, it is respectfully submitted that the Office Action has not established that the subject matter of the pending claims is suggested by the cited references, whether they are considered individually or in combination. Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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